

Customer No. 31013

Atty. Docket No.: 062369/30280

PATENT



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of Eastman et al.

Examiner: SHARMA, SUJATHA R.

Application No. : 10/626,244

Group Art Unit.: 2618

Filed : July 24, 2003

Confirmation No.: 9995

Title : COMPUTER BASED MULTI-CHANNEL RADIO SYSTEM AND
USER INTERFACE

CERTIFICATE OF MAILING UNDER 37 CFR 1.8

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Date: May 19, 2010

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Aaron S. Haleva, Reg. No. 44,733

May 19, 2010

APPELLANTS REPLY BRIEF- ORAL HEARING REQUESTED

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a Reply Brief submitted in Applicants' appeal from the final rejection contained in the Office Action dated September 25, 2007, which finally rejected claims 1-26. This Reply Brief is submitted in response to the Examiner's Answer, filed on March 19, 2010, and responds to the arguments made therein. In particular, this Reply Brief responds

to the “Response to Argument” section of the Examiner’s answer, appearing at pp. 12-16 thereof.

Additionally, an oral hearing is requested for this appeal, in a Request For Oral Hearing submitted herewith.

In connection with this Reply Brief, or with the Request For Oral Hearing submitted herewith, authorization is hereby given to charge any fee deficiency and credit any overpayment to Deposit Account No. 50-0540.

REAL PARTY IN INTEREST

The real party in interest in this appeal is XM Satellite Radio, Inc., of New York, New York.

RELATED APPEALS AND INTERFERENCES

Applicants are not aware of any related appeals or interferences which directly affect, or are directly affected by, or have a bearing on the Board’s decision in this appeal.

STATUS OF CLAIMS (REVISED)

The following status of claims reflects the clarified pending final rejections as set forth in the Examiner’s Answer, which, in response to the Remand To The Examiner decided on November 30, 2009, were adjusted and clarified in the Examiner’s Answer. This is Applicant-Appellant’s first opportunity to cogently respond to the *actual* claim rejections being asserted in this case.

Claims 1-26 are pending in the present application.

Claims 1-5, 8-12, 20-22 and 26 stand finally rejected under U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2007/0118833 to Hilt (“Hilt”) in view of U.S. Patent Application Publication No. 2004/0049389 to Marko, et al. (“Marko”) and further in view of U.S. Pat. No. 6,553,077 to Rindsberg (Rindsberg).

Claims 6 and 24 stand rejected under U.S.C. § 103(a) as being unpatentable over Hilt and Marko in view of Rindsberg and further in view of U.S. Patent No. 7,194,687 to Sezan (“Sezan”).

Claim 7 stands rejected under U.S.C. § 103(a) as being unpatentable over Hilt and Marko in view of Rindsberg, and further in view of U.S. Pat. Application Publication No. 2004/0196179 to Turnbull (“Turnbull”).

Claims 13-15 stand rejected under U.S.C. § 103(a) as being unpatentable over Hilt in view of Marko.

Claims 16, 18, 23 and 25 stand rejected under U.S.C. § 103(a) as being unpatentable over Marko in view of Rindsberg.

Claim 17 stands rejected under U.S.C. § 103(a) as being unpatentable over Marko in view of Rindsberg and further in view of Sezan.

Finally, for the first time in the revised (second) Examiner’s Answer, the Examiner now asserts that claim 19 stands rejected under U.S.C. § 102(e) (sic) as being unpatentable over Marko and Rindsberg in view of Turnbull.

Applicants note formally for the record that they vehemently object to entry of a new rejection at this late stage. Applicants did not address claim 19 in their Appeal Brief, because the Examiner never stated this rejection in the Final Office Action of September 25,

2007. The Examiner never articulated a rejection of claim 19 in the first Examiner's Answer, filed on April 11, 2008. Moreover, even now, Applicants fail to understand under which section of the patent law this rejection is entered. The rejection is identified as being under "35 U.S.C. § 102(e)", and yet a three way combination characteristic of a rejection under 35 U.S.C. § 103(a) is presented.

Once again the Examiner is muddying the record with poorly contemplated and improperly articulated positions. It is completely unfair to allow this newly articulated rejection which could have been entered – with a little attention to detail – in two earlier opportunities – the Final Office Action and the first Examiner's Answer. At some point Applicants' may rely on what the Examiner actually says, and that he be held to that.

Applicants respectfully request that the Board not allow this rejection to go forward, and find that claim 19 is not rejected and is thus patentable.

Finally, Applicants also note for the record the illegality of asserting Marko as a prior art reference against the present application, as set forth below, pursuant to 35 U.S.C. § 103(c). Applicants respectfully request that the Board not allow any rejection which includes a combination of references including Marko to go forward, and thus find that claims 1-26 are not properly rejected and are thus all patentable.

STATUS OF AMENDMENTS

An Amendment After Final was submitted on November 28, 2007 with minor changes to claims 1 and 13 for clarification purposes. The Examiner maintained the rejections set forth above and refused to enter the Amendment, stating that the amendment "requires

further consideration and/or search." A Pre-Appeal Conference Request and a Pre-Appeal Brief was filed along with a Notice of Appeal on December 21, 2007.

SUMMARY OF CLAIMED SUBJECT MATTER

A detailed summary of the claimed subject matter was provided in Applicants' Appeal Brief, and is incorporated herein by reference.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL (REVISED)

The issues on appeal, given the revised status of claims set forth above, are as follows:

1. Whether U.S. Pat. Application Publication No. 2004/0049389 to Marko, et al. ("Marko") can be cited against any of the pending claims in any rejection under 35 U.S.C. § 103(a), given that Marko is under common assignment with the present application, and only qualifies as prior art under 35 U.S.C. § 102(e) (being published **after** the filing date of the present application), and thus pursuant to 35 U.S.C. § 103(c), Marko cannot preclude patentability under 35 U.S.C. § 103(a).

Given that Marko is used as a necessary element of each and every rejection articulated by the Examiner, as clearly set forth in the Examiner's Answer, removal of the Marko reference necessitates removal of all of the pending rejections, and a declaration that the pending claims are patentable.

2. Whether claims 1-5, 8-12, 20-22, and 26 are patentable over Hilt in view of Marko and further in view of Rindsberg.

3. Whether claims 6 and 24 are patentable over Hilt and Marko in view of Rindsberg and further in view of Sezan.

4. Whether claim 7 is patentable over Hilt and Marko in view of Rindsberg and further in view of Turnbull.

5. Whether claims 13-15 are patentable over Hilt in view of Marko.

6. Whether claims 16, 18, 23 and 35 are patentable over Marko in view of Rindsberg.

7. Whether claim 17 is patentable over Marko in view of Rindsberg and further in view of Sezan.

8. Whether claim 19 is patentable as never finally rejected, and thus not within the scope of this appeal.

ARGUMENT

I. Marko cannot be used as a reference in any rejection against the pending claims under 35 U.S.C. § 103(a), given that Marko is under common assignment with the present application, and only qualifies as prior art under 35 U.S.C. § 102(e). Thus pursuant to 35 U.S.C. § 103(c), Marko cannot preclude patentability under 35 U.S.C. § 103(a).

Marko was published as U.S. Patent Application Publication No. 2004/0049389, on March 11, 2004. This is some eight months after the filing of the present application on July 24, 2003. Therefore Marko would only qualify as prior art against the present application under 35 U.S.C. § 102(e) (being published **after** the filing date of the present application). In addition, Marko is under common assignment with the present application, and thus pursuant to 35 U.S.C. § 103(c), Marko is not a proper prior art reference, and thus Marko cannot preclude patentability of the present application under 35 U.S.C. § 103(a).

The Evidence Appendix provided below contains a copy of the USPTO assignment record for U.S. Patent Application No. 10/238,555, the Marko reference cited in the various rejections of the pending claims. The record shows that this application was assigned to XM Satellite Radio, Inc. prior to September 10, 2002, clearly establishing that Marko is under common assignment with the present application.

II. Claims 1-5, 8-12, 20-22, and 26 are patentable over Hilt in view of Marko and further in view of Rindsberg.

The Examiner's Answer admits that a combination of only Hilt and Rindsberg does not teach claims 1-5, 8-12, 20-22, and 26. Examiner's Answer at 3-5. Because Marko is an improper reference under 35 U.S.C. § 103(c) as set forth above, Marko cannot be applied against these claims, and the rejection must be removed. Thus, claims 1-5, 8-12, 20-22, and 26 are patentable over Hilt and Rindsberg, as admitted by the Examiner's Answer.

Additionally, at page 13 of the Examiner's Answer the Examiner asserts that Hilt discloses (at ¶ 0020) an XM receiver to include a browser which reads on the claimed GUI. Applicants respectfully traverse. The *claimed GUI* is used to display non-audio data received from the radio receiver, which in turn is received by the receiver from the broadcast stream, i.e., over the air. Nowhere does Hilt teach displaying any such data. Rather, Hilt contemplates displaying an HTML web page obtained over the Internet, using a **browser**. Hilt at ¶ 0022. ("Server 106 then transmits the resolved bookmarks as a formatted HTML page to browser 114 and displays the account of user 202 by transmission step 208"). Moreover, the browser in Hilt is only used to accomplish two way exchange bookmarks between the first computer connected to the XM receiver and a second computer located remotely, and accessed by the first computer only over an Internet connection. "Bookmarks"

are not the claimed “data associated with the plurality of channels includes a plurality of channel numbers, a plurality of artist names, a plurality of song titles, and a plurality of channel names.” Therefore Hilt cannot teach the claimed GUI.

In fact, the entire Hilt system “mimics the control of browser 114 by a user and thus prevents the triggering of firewall 110.” Hilt at ¶ 0021. Mimicking a person surfing the Internet via a browser, and viewing HTML pages at a defined URL in such mimicking only to resolve bookmarks, **does not teach** extracting non-audio data from a satellite radio broadcast stream decoded by a satellite radio receiver and then displaying that data on a GUI of a computer coupled to the radio receiver. Hilt nowhere discloses the claimed GUI that (i) selectively displays at least a portion of the data associated with the plurality of channels, where (ii) the data associated with the plurality of channels includes a plurality of channel numbers, a plurality of artist names, a plurality of song titles, and a plurality of channel names, as claimed. Hilt simply discloses a computer with a display. A generic Internet browser to present HTML pages is not the claimed GUI.

The claimed invention does not access the information it displays via the Internet, or via a browser for that matter. It decodes data associated with the received channels which it receives at the receiver (such data is clearly not in HTML format and is not found at a URL) and selectively displays such data on a computer GUI. It uses a computer as a sophisticated display for a radio receiver in a radio system that broadcasts both a plurality of channels and a plurality of auxiliary data associated with each channel.

Neither Marko (dealing with text to speech applications) – even if it were a legitimate prior art reference, which it is not -- nor Rindsberg (dealing with customization of the selection of channels among a plurality of channels) teaches the claimed GUI or the

display via said GUI of data associated with channels received in a radio, e.g., satellite, broadcast stream, where such data is received and decoded **at a receiver from the broadcast stream.**

Thus, even if these references are combined, they would not yield the claimed invention, to wit: receiving a plurality of channels and data associated with them on a receiver coupled to a computer, and displaying at least a portion of the data via a GUI on a display coupled to the computer, wherein the data is simultaneously updated.

III. Claims 6 and 24 are patentable over Hilt and Marko in view of Rindsberg and further in view of Sezan.

The Examiner's Answer admits that a combination of only Hilt and Rindsberg with Sezan does not teach claims 6 and 24. Examiner's Answer at 7. Because Marko is an improper reference under 35 U.S.C. § 103(c), Marko cannot be applied against these claims, and the rejection must be removed. Thus, claims 6 and 24 are patentable over Hilt and Rindsberg combined with Sezan, as admitted by the Examiner's Answer.

Second, these dependent claims are patentable by virtue of the elements of their respective base claims, independent claims 1 and 20, as described in Section I above.

IV. Claim 7 is patentable over Hilt and Marko in view of Rindsberg and further in view of Turnbull

The Examiner's Answer admits that a combination of only Hilt and Rindsberg with Turnbull does not teach claim 7. Examiner's Answer at 7-8. Because Marko is an improper reference under 35 U.S.C. § 103(c), Marko cannot be applied against these claims, and the rejection must be removed. Thus, claim 7 is are patentable over Hilt and Rindsberg

combined with Turnbull, as admitted by the Examiner's Answer.

Second, this dependent claim is patentable by virtue of the elements of its base claim, independent claim 1, for the reasons described in Section II above.

V. Claims 13-15 are patentable over Hilt in view of Marko

The Examiner's Answer admits that only Hilt taken alone does not teach claims 13-15. Examiner's Answer at 8-9. Because Marko is an improper reference under 35 U.S.C. § 103(c), Marko cannot be applied against these claims, and the rejection must be removed. Thus, claims 13-15 are patentable over Hilt alone, as admitted by the Examiner's Answer.

Additionally, Applicants find the rejection of claims 13-15 somewhat confusing. In the rejection of claim 1, the Examiner's Answer argues that Hilt teaches the claimed GUI (which it does not, as argued above). Here, in articulating the rejection of claims 13-15, the Examiner's Answer now claims that it is *Marko* that teaches the claimed GUI which (i) selectively displays at least a portion of the data associated with the plurality of channels, where (ii) the data associated with the plurality of channels includes a plurality of channel numbers, a plurality of artist names, a plurality of song titles, and a plurality of channel names, as claimed.

Thus, the Examiner's Answer admits that Hilt alone clearly cannot teach the invention claimed in claims 13-15.

Moreover, Neither Hilt nor Marko teach the claimed element of "a port for transmitting data associated with the plurality of channels, transmitting an output signal representative of selected channels among the plurality of channels, and for receiving control signals from a computer having a graphical user interface, wherein the graphic user

interface selectively displays the data associated with the plurality of channels simultaneously and user selectively controls the channel decoder by selecting the selected channels on the graphical user display. “ Because the receiver of Marko does not in any way contemplate a computer based radio system, no such port for transmitting and receiving data is taught.

VI. Claims 16, 18, 23 and 25 are patentable over Marko in view of Rindsberg

The Examiner’s Answer admits that Rindsberg by itself does not teach claims 16, 18, 23 and 25. Examiner’s Answer at 9-11. Because Marko is an improper reference under 35 U.S.C. § 103(c), Marko cannot be applied against these claims, and the rejection must be removed. Thus, claims 16, 18, 23 and 25 are patentable over Hilt alone, as admitted by the Examiner’s Answer.

Additionally, the rejection of claims 16, 18, 23 and 25 as set forth in the Examiner’s Answer (see p. 9-10) relies on Rindsberg to teach (i) simultaneously updating and displaying of the associated data for a selected plurality of channels among the plurality of channels wherein the data associated with the plurality of channels includes a plurality of channel numbers, a plurality of artist names, a plurality of song titles, and a plurality of channel names; and (ii) selectively controlling a remotely coupled channel decoder on a radio receiver via the graphical user interface.

Rindsberg nowhere teaches simultaneous updating of associated data. Further, Rindsberg nowhere teaches selectively controlling a remotely coupled channel decoder on a radio receiver via the graphical user interface. There is no “remotely coupled channel decoder” taught or suggested by Rindsberg. Rindsberg is about customized selection of audio channels on a single radio receiver. Because Rindsberg does not contemplate the claimed invention

whatsoever, it is not concerned with using a computer in connection with a radio receiver.

Thus Rindsberg does not – and cannot – teach a GUI on a computer that can be used control a remote channel decoder.

Thus, even if Marko was a legitimate reference – which it is not – the combination of Marko and Rindsberg would not teach the invention claimed in claims 16, 18, 23 and 25.

VII. Claim 17 is patentable over Marko in view of Rindsberg and further in view of Sezan

The Examiner's Answer admits that a combination of only Hilt and Rindsberg with Turnbull does not teach claim 7. Examiner's Answer at 7-8. Because Marko is an improper reference under 35 U.S.C. § 103(c), Marko cannot be applied against these claims, and the rejection must be removed. Thus, claim 7 is are patentable over Hilt and Rindsberg combined with Turnbull, as admitted by the Examiner's Answer.

Second, this dependent claim is patentable by virtue of the elements of its base claim, independent claim 16, for the reasons described in Section VI above.

VIII. Claim 19 is patentable as never finally rejected, and thus not within the scope of this appeal

As noted above, it is only in the revised (second) Examiner's Answer that this rejection was ever articulated. Two prior bites at the apple are enough. It would be unfair to introduce a new ground of rejection for a claim that was not addressed before. The Final Office Action was also signed off by the Examiner's SPIE, and the first filed Examiner's Answer, back in May of 2008, was signed off by two SPIEs. Enough is enough.

Applicants respectfully object to the entry of this new rejection, and respectfully request that claim 19 be declared patentable as not previously rejected.

Additionally, the Examiner's Answer admits that a combination of only Rindsberg and Turnbull does not teach claim 19. Examiner's Answer at 11-12. Because Marko is an improper reference under 35 U.S.C. § 103(c), Marko cannot be applied against these claims, and the rejection must be removed. Thus, claim 19 is patentable over Hilt alone, as admitted by the Examiner's Answer.

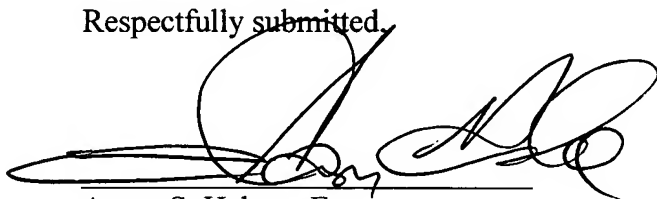
Finally, claim 19 is patentable by virtue of the novel elements recited in its base claim, independent claim 16, as described above in Section VI.

CONCLUSION

For the reasons advanced above, Applicants respectfully submit that claims 1-26 are allowable over the cited references. Applicants therefore respectfully request that the rejections of claims 1-26 under 35 U.S.C. §103(a) variously in view of Hilt, Marko, Rindsberg, Sezan and Turnbull be reversed, given both (i) the teachings of these references themselves and (ii) the fact that Marko cannot legally be cited as a reference against the pending claims under 35 U.S.C. § 103(a), given that (a) Marko was published after the filing date of the present application, and (b) Marko is under common assignment with the present application. Thus, under 35 U.S.C. § 103(c), Marko cannot preclude patentability of any of the pending claims.

Finally, in addition to any other basis, Applicants further respectfully request that no late-entered rejection of claim 19 be allowed, and that absent any timely articulated rejection, claim 19 be declared patentable.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'A. Haleva', is written over a horizontal line.

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CLAIMS APPENDIX

A detailed claims appendix was provided in Applicants' Appeal Brief, and is incorporated herein by reference.

EVIDENCE APPENDIX

The following is a copy of the USPTO assignment record for U.S. Patent Application No. 10/238,555, the Marko reference cited in the various rejections of the pending claims. The record shows that this application was assigned to XM Satellite Radio, Inc. prior to September 10, 2002.

Patent Assignment Details

NOTE: Results display only for issued patents and published applications. For pending or abandoned applications please consult USPTO staff.

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Total properties: 1

Patent #: NONE

Issue Dt:

Application #: 10238555 **Filing Dt:** 09/10/2002

1 Publication #: US20040049389 **Pub Dt:** 03/11/2004

Title: Method and apparatus for streaming text to speech in a radio communication system

Assignors

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Exec Dt: 09/03/2002

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None.